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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,843	01/07/2002	James Samsoondar	31773-CIP1	3741

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EXAMINER

LIN, JERRY

ART UNIT	PAPER NUMBER
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1631

MAIL DATE	DELIVERY MODE
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05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/040,843

Applicant(s)

SAMSOONDAR, JAMES

Examiner

Jerry Lin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18, 20, 22 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18, 20, 22 and 29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 19, 2006 has been entered.

Status of the Claims

Claims 12-18, 20, 22, and 29-40 are under examination.

Claims 1-11, 19, 21, and 23-28 are cancelled (1-11 and 23-28 were unelected).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12, 13, 15-17, 20, 22, 29-35, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Megevand et al. (Experimental & Applied Acrology (1993) Volume 17, pages 115-128) in view of Bjornson et al (US 5,206,568).

The instant claims are drawn to a method of aspirating fluid into a tip with two open ends, sealing one end after fluid is drawn into the tip, and using the sealed tip as a reservoir for further dispensing or mixing.

Regarding claims 12, 29, and 30-33, Megevand et al. teach a method of aspirating material into a dispensing tip with two open ends and sealing one end after material is aspirated into the dispensing tip (page 120, 3rd paragraph from the top). Megevand et al. also teach sealing the tip with paraffin, which would require Megevand et al. to press (i.e., compress or plug) the paraffin onto the opening of the tip.

However Megevand et al. do not teach inserting a second dispensing tip through the open first end of the sealed tip and aspirating fluid from that end, nor do they teach dispensing a diluent or reagent in the first tip from a second tip to form a mixture.

Regarding claims 12, 29 and 30-33, Bjornson et al. teach a method of aspirating a fluid into a reservoir (column 13, lines 13-30; column 21, lines 50-61; column 22, lines 31-46; column 5, lines 50-68); inserting a second dispensing tip in said sample reservoir and aspirating a portion or all of said fluid from said sample reservoir into said second dispensing tip (column 10, lines 1-44); or withdrawing a reagent into a second dispensing tip and dispensing the reagent through the first end of the sample reservoir to form a mixture (column 10, lines 1-44; column 22, lines 31-46; column 24, line 8-column 26, line 54).

Regarding claims 13, 15, 18, and 36, Megevand et al. teach sealing the tip with paraffin, which would require Megevand et al. to press (i.e., compress or plug) the

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paraffin onto the opening of the tip, as well as move (displace) the material inside the tip away from the sealable end (page 120, 3rd paragraph from the top).

Regarding claims 16, 17, 20, 22, 34, 35, and 37- 40, Bjornson et al. also teach wherein the steps are preformed by a chemistry analyzer apparatus (Abstract); where the steps are manually performed (column 1, lines 30 – 54); wherein the second dispensing tip is sized to reach the second end of the reservoir (column 35, lines 3-40); wherein the step of withdrawing is followed by removing the mixture into the second dispensing tip and dispensing the mixture into the reservoir which is repeated (column 35, lines 3-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the methods of Megevand et al. and Bjornson et al. to gain the advantage of minimizing transfer loss. Megevand et al. teach a method that allows the practitioner to aspirate material directly into a reservoir with having to transfer that material into another receptacle. Since Megevand et al. eliminates the need for a transfer step, the transfer loss is minimized. Such a method would be advantage for working with small quantities of fluid. Bjornson et al.'s method is designed to work with small quantities of fluid typically used in analytical chemistry (Bjornson et al., abstract). Furthermore, Bjornson et al. teach that their method may be used with any fluid receptacle (Bjornson et al., column 5, lines 50-68). Thus one of ordinary skill in the art using Bjornson et al.'s method would be motivated to also use Megevand et al.'s method to minimize the transfer loss of fluids.

Response for Arguments

4. The Applicants first respond to this rejection by stating that the references are related to a different technical field. In particular Megevand et al. is drawn to aspirating mites, whereas the other references are related to fluids. While it is true that the references are drawn to aspirating different materials, all the reference are drawn to aspirating some material into a pipette. Thus, one seeking to contain any material within a pipette would be motivated to draw upon any of these references, whether the material be mites or fluids. Furthermore, one of ordinary skill in the art would also expect success in combining these references, since the method of containing the material relies on physical barriers. Thus there is no technical barrier for combining these references.

The Applicants also respond to this by stating that Megevand et al. teach away from the limitation of opening one end of the pipette, since Megevand et al. want to keep the mites trapped in the pipette. While it is true that Megevand et al. want to keep the mites within the pipettes during the collection process, Megevand et al. also teach releasing the mites by removing the gauze or paraffin. Thus, Megevand et al. do teach accessing the material within a pipette by removing one of the ends.

This rejection is maintained from the previous office action.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Megevand et al. (Experimental & Applied Acrology (1993) Volume 17, pages 115-128)

in view of Bjornson et al. (US 5,206,568) further in view of in view of Ebersol et al. (US 5,578,460).

Megevand et al. and Bjornson et al. are applied as above.

Neither Megevand et al. or Bjornson et al. teaching sealing the tip by heat.

Regarding claim 14, Ebersole et al. teach method where a dispensing tip with a first and second end, wherein the second end is sealed with heat and defines a sample reservoir (column 24, line 64-column 25, line 18).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the references of Megevand et al., Bjornson et al., and Ebersole et al. to gain the advantage of a permanent seal of the first tip. The motivation to combine Megevand et al. and Bjornson et al. is applied as above. Although Megevand et al. teach a method of sealing the tip with paraffin, their method is intended to only be a temporary seal. Such a seal would not be sufficient for experiments that require vigorous shaking or centrifuging. Thus one of ordinary skill in the art would be motivated to find a permanent seal. Ebersole et al. teach a method of creating a permanent seal by melting the end of the tip. Thus one of ordinary skill in the art seeking to conduct chemical analysis using Bjornson et al.'s apparatus, minimizing transfer loss, and creating a permanent seal would be motivated to combine the methods of Megevand et al., Bjornson et al., and Ebersole et al.

Response to Arguments

6. The Applicants have responded to this rejection by stating that the references are in different technical fields and that Megevand et al. teach away from the claimed invention. See the Examiner's response above.

This rejection is maintained from the previous office action.

Conclusion

This is a Request for Continued Examination of applicant's Application No. 10/040843. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 10:00-6:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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